

REMARKS

By this amendment claims 1-59 are pending in the application. Claims 44-48, 57 and 58 have been canceled. Claims 1 and 49 have been amended. New claim 59 has been added. No new matter has been added by this amendment.

Claims 1-3, 7-10, 13-15, 18, 19, 26, 33, 38-41, 43 have been rejected under 35 U.S.C. §102(e) as being anticipated by Fields (U.S. Patent Publication No. 2002/00069154). Claims 4-6, 10-12, 16, 20, 21, 34-36, 42 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Fields. Claims 17, 27-32 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Fields in view of Slight et al. (U.S. Patent Publication No. 2002/0077954). Claims 22-25, 37, 49-56, have been rejected under 35 U.S.C. §103(a) as being unpatentable over Fields in view of Vashistha et al. (U.S. Patent Publication No. 2001/0051913). These rejections are respectfully traversed.

As recited in the independent claims, the present application is directed to a computer-implemented method for filling an invitation for bids of at least one performance to be effected by a bidder against payment. The present system, as recited in the independent claims, provides a database comprising at least one performance description and a price description for each of the plurality of predetermined performances. After a user selects at least one performance description and at least one price description of the select performance, a list of unpriced performances desired by a user or buyer is generated.

The generated list of performances is unpriced meaning that a price is not generated with the list. The list of unpriced performances is forwarded to a plurality of bidders. The bidders upon receiving the list of unpriced performances, input or

cause to have input a bid price into a bid mask, where the bid price is assigned to at least one performance description of the list of unpriced performances. The bid price is a price to be paid to the bidder for the performance of the described work. These, among other features, are recited in the independent claims 1 and 49.

In contrast, Figure 15 of the *Fields* published application illustrates a template page in which a user completes the request for a proposal template pages illustrated in *Fields*' Figures 11-14. After completing the template pages, the user is presented with a final patent Request for Proposal (RFP) as shown in Figure 15. Element 124 shows the expected application fee the user desires to pay as well as the desired prior art search fee, desired prosecution fee, and desired provisional patent fee. The system disclosed in the *Fields* published application automatically fills in the price for the service based on the template pages the expected competitive fee for the users request for proposal. As shown in Figure 15, the text that states, "Fee Bid has formulated competitive fees for your RFP."

Accordingly, the *Fields* published application does not disclose generating a list of unpriced performances desired by a buyer by selecting at least one of the predetermined performances from the data base and by including the respected performance description in the list of performances, forwarding the list of unpriced performances to a plurality of bidders, or receiving a bid from at least one of the plurality of bidders each received bid including a bid price input to a bid mask by the bidder and assigned to at least one performance description of the list of unpriced performances, the bid price stating the price to be paid to the bidder for effecting the respective performance by the bidder as recited in claim 1.

Therefore the 35 U.S.C. § 102(e) rejection of claims 1-3, 7-10, 13-15, 18, 19, 26, 33, 38-41 and 43 should be withdrawn. In addition the rejection of claims 4-6, 10-12, 16, 20, 21, 34-36 and 42 under 35 U.S.C. §103(a) as being unpatentable over the *Fields* published application should also be withdrawn because the *prima facie* case of obviousness has not been made due to the fact that *Fields* fails to disclose all of the features recited in the independent claims.

As for the rejection of claims 17 and 27-32 under 35 U.S.C. §103(a) as being unpatentable over *Fields* in view of *Slaight et al.*, *Slaight* fails to cure the deficiencies of *Fields*. Neither *Fields* nor *Slaight et al.* disclose or suggest, individually, or in combination, all of the features recited in the claims, including independent claim 1. Therefore, the rejection under 35 U.S.C. §103 should be withdrawn.

As for claims 22-25 and 37, these claims were rejected under 35 U.S.C. §103(a) as being unpatentable over *Fields* in view of *Vashistha et al.*, *Vashistha et al.* does not cure the deficiencies of *Fields* as outlined above. Neither *Fields* nor *Vashistha et al.* disclose or suggest either individually or in combination all the features recited in the claims. Therefore the rejection under 35 U.S.C. §103(a) of claims 22-25 and 37 should be withdrawn.

Independent claim 49 recites, among other features, generating a list of desired and unpriced performances from the archive performances and distributing the generated list of performances inviting the input of a bid to a plurality of bidders as well as receiving a bid submitted from at least one of the plurality of bidders, wherein each submitted bid includes a price input by the bidder assigned to at least one of the distributed list of performances and wherein the assigned price is the bid price to be paid to the bidder for effecting the respective performance by the bidder.

These features are not disclosed or suggested by *Fields* or by *Vashistha et al.*, individually, or in combination. Therefore, a *prima facie* case of obviousness has not been made because all of the features recited in claim 49 are not disclosed or suggested by the applied prior art.

Additionally in the rejections of claims 4-6, 10-12, 16, 20, 21, 34-36 and 42 under 35 U.S.C. §103(a) as being unpatentable over *Fields* and in view of the Official Notice, the Official Notice taken in each of the claim rejections is traversed for the following reasons.

In response to the Examiner's assertion on page 9 of the Office Action that the Applicants have not provided adequate traversal per MPEP §2144.03(c), Applicants disagree. Applicants noted in the response filed April 4, 2005, on pages 7 and 18 in response to the rejection of claim 35 and 36 over *Fields* and Official Notice that "the contract list of performances is the list of performances with the prices for each performance being included based on the prices stated in the selected bid. Such a feature would not have been obvious in view of *Fields* because the *Fields*' system generates the prices for the list of performances before the request for proposes are sent to the attorneys and therefore, before any attorney is selected for performing the work (See *Fields* at 77, 78, 87, 88)." In addition, on page 13 of the November 14, 2005 response to which Applicants referenced on page 18 of the April 4, 2005 response, clearly list a number of different facts as to why the applied prior art is different from claims 35 and 36. Thus, not only have Applicants pointed out why the assorted facts are not common knowledge, but why even if common knowledge, they would not have lead to the present invention.

Section 2144.03(c) of the MPEP states that an Applicant must specifically point out the supposed errors in the Examiner's action, which could include stating why the official notice fact is not considered to be common knowledge or well known in the art, it does not limit that discussion to being only factual matters. (See *In re Chevenard*, 139 F.2d 713, the quoted section references another CCPA opinion of *In re Gunther*, 125 F.2d 1020). *In re Gunther* held that "moreover, the Examiner stated that it was well known in the art to use dry or super heated steam to avoid undue condensation and dilution of the cooking liquor. This statement was not challenged before the Patent Office. If the Appellant believes that the cited art did not disclose this, he could, under the rules of the Patent Office, have required an affidavit of the Examiner's supporting such statement". Applicants have repeatedly request such affidavits. Therefore, Applicants have adequately traversed the Examiner's Official Notice to the satisfaction of the holdings in *In re Chevenard* and *In re Gunther*.

Finally, *In re Zurko*, 258 F.3d 1386 states with respect to core factual findings and a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience and – or on its' assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings which is also quoted beneath the citation to *Zurko* on MPEP page 2100-144.

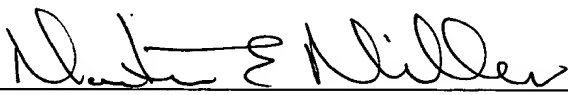
Accordingly, the Examiner is respectfully requested for a third time to point to some concrete, evidence, or an affidavit or declaration setting forth specific factual statements, or an explanation to support the findings as required under 37 C.F.R.

§1.104(d)(2). Claims 1-43, 49-56 and 59 are in condition for allowance and notification to that effect is respectfully requested.

Should any questions arise in connection with this application, or should the Examiner believe a telephone conference would be helpful in resolving any remaining issues pertaining to this application, the undersigned respectfully requests that he be contacted at the number indicated below.

Respectfully submitted,
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